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|---|----------------------|------------------------|-------------------------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 10/611,419 | |
| | Filing Date | June 30, 2003 | |
| | First Named Inventor | Fu | |
| | Art Unit | 2652 | |
| | Examiner Name | Chen, Tianjie | |
| Total Number of Pages in This Submission | 8 | Attorney Docket Number | Q01-1041-US1 / 11198.71 |

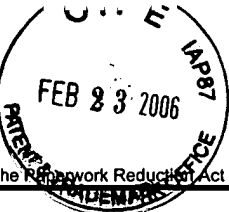
| ENCLOSURES (Check all that apply) | | |
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| <input checked="" type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> After Allowance Communication to TC |
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| <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application | <input type="checkbox"/> Landscape Table on CD | |
| <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | | |
| Remarks | | |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | | | |
|--|--------------------------------|----------|--------|
| Firm Name | Law Office of Steven G. Roeder | | |
| Signature | | | |
| Printed name | James P. Broder | | |
| Date | February 21, 2006 | Reg. No. | 43,514 |

| CERTIFICATE OF TRANSMISSION/MAILING | | | |
|---|-----------------|------|-------------------|
| I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below: | | | |
| Signature | | | |
| Typed or printed name | James P. Broder | Date | February 21, 2006 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2006☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 0.00**Complete if Known**

| | |
|----------------------|-------------------------|
| Application Number | 10/611,419 |
| Filing Date | June 30, 2003 |
| First Named Inventor | Fu |
| Examiner Name | Chen, Tianjie |
| Art Unit | 2652 |
| Attorney Docket No. | Q01-1041-US1 / 11198.71 |

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: 50-1141 Deposit Account Name: Steven G. Roeder

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s)
under 37 CFR 1.16 and 1.17☐ Credit any overpayments**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION** (All the fees below are due upon filing or may be subject to a surcharge.)**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

| Application Type | FILING FEES | | SEARCH FEES | | EXAMINATION FEES | | Fees Paid (\$) |
|------------------|-------------|-----------------------|-------------|-----------------------|------------------|-----------------------|----------------|
| | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | |
| Utility | 300 | 150 | 500 | 250 | 200 | 100 | |
| Design | 200 | 100 | 100 | 50 | 130 | 65 | |
| Plant | 200 | 100 | 300 | 150 | 160 | 80 | |
| Reissue | 300 | 150 | 500 | 250 | 600 | 300 | |
| Provisional | 200 | 100 | 0 | 0 | 0 | 0 | |

2. EXCESS CLAIM FEES

| Fee Description | Fee (\$) | Small Entity Fee (\$) |
|--|----------|-----------------------|
| Each claim over 20 (including Reissues) | 50 | 25 |
| Each independent claim over 3 (including Reissues) | 200 | 100 |
| Multiple dependent claims | 360 | 180 |

| | | | | |
|---------------------|---------------------|-----------------|----------------------|----------------------------------|
| Total Claims | Extra Claims | Fee (\$) | Fee Paid (\$) | Multiple Dependent Claims |
| 52 | 0 | 50 | 0 | |

HP = highest number of total claims paid for, if greater than 20.

| | | | |
|----------------------|---------------------|-----------------|----------------------|
| Indep. Claims | Extra Claims | Fee (\$) | Fee Paid (\$) |
| 6 | 0 | 200 | 0 |

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

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|---------------------|---------------------|---|-----------------|----------------------|
| Total Sheets | Extra Sheets | Number of each additional 50 or fraction thereof | Fee (\$) | Fee Paid (\$) |
| | | | | |

- 100 = / 50 = (round up to a whole number) x =

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): _____

Fees Paid (\$)**SUBMITTED BY**

| | | | |
|-------------------|-----------------|--|------------------------|
| Signature | | Registration No. (Attorney/Agent) 43,514 | Telephone 858-487-4077 |
| Name (Print/Type) | James P. Broder | | Date February 21, 2006 |

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Fu, et al.)
Serial No: 10/611,419) Art Unit
Filed: June 30, 2003) 2652
For: POSITIONER FOR A DISK DRIVE THAT)
OFFSETS THE RESULTANT FORCE AT THE)
ACTUATOR HUB TO PRECISELY POSITION)
A DATA TRANSDUCER)
Examiner: Chen, Tianjie)
Attorney Docket: Q01-1041-US1 / 11198.71)

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement dated February 7, 2006, having a shortened statutory period for response set to expire on March 7, 2006, please review the above-captioned patent application as provided below. This response is timely filed within the one-month deadline for response.

CERTIFICATE OF MAILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this the 21st day of February, 2006.

JAMES P. BRODER, Attorney for Applicants – Registration No. 43,514

ELECTION

The Applicants respectfully elect with traverse the claims of Species I, which Applicants believe comprises claims 69-120. Applicants further respectfully submit that at least claims 69-70, 78-80, 88-91, 96-98, 103, 113 and 120 are believed to be generic to Species I, II and III as defined by the Patent Office. Further, claims 69-120 are believed to be subgeneric, as these claims are believed to read on both Species I and II.

ARGUMENT

The Applicants respectfully traverse the election requirement with respect to election of a single species as defined by the Patent Office. The Patent Office has determined that the “application contains claims directed to the following patentably distinct species of the claimed invention: Species I: drawn from Figures 2A-2C; Species II: drawn from Figure 3; Species III: drawn from Figure 4.” As set forth below, the Applicants submit that the restriction requirement is improper and should be withdrawn.

First, the guidelines of the statutes and the rules govern whether a restriction requirement is proper. More specifically, 35 U.S.C. § 121 states in relevant part: “If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions.” (35 U.S.C. § 121; emphasis added).

Further, 37 CFR 1.142(a) states in relevant part: “If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division).” (37 CFR 1.142(a); emphasis added).

In the context of a restriction requirement, MPEP § 802.01 defines “independent” as follows: “The term ‘independent’ (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.” (MPEP § 802.01). The MPEP further clarifies the definition of “independent” by providing examples, stating in relevant part: “An article of apparel such

as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.” (MPEP § 806.04(A)). In the present case, the differences between the three species set forth by the Patent Office are not nearly as glaring, and are much less bright-lined than the clear examples expressed above in MPEP § 806.04(A).

For example, all three of the species identified by the Patent Office are directed toward disk drives including a positioner that positions a data transducer, the positioner having a magnet assembly and one or more conductors, or methods for positioning a data transducer that include use of such a positioner. In accordance with the Figures upon which the Patent Office relies in identifying the various species, each of the conductors has several substantially similar features to one another. As a consequence, the Applicants submit that the different species set forth by the Patent Office are not independent.

In the Restriction Requirement, the Examiner appears to have drawn a distinction between the components illustrated in Figures 2A-2C, 3 and 4 of the present application based upon the shapes, configurations and/or positioning of the magnet assembly and the conductor(s) of the positioner in the disk drive. However, the Patent Office appears to be disregarding that the structural components included in the embodiments illustrated in the Figures are not completely unconnected in design, operation, or effect, as required for a finding of independent inventions.

Moreover, “for purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.” (Guidelines, MPEP 803; emphasis added). The Applicants respectfully submit that the Patent Office has not adequately demonstrated reasons or examples to support its conclusions. Moreover, the Patent Office has not provided any explanation of separate classification or separate status in the art for the various species, or that different fields of search are required to examine the claims of each species together in one application.

Thus, the Applicants respectfully submit that the species identified by the Patent Office (solely by Figure numbers) are not wholly unconnected in design, operation, or

effect. Accordingly, the Applicants submit that examining the embodiments illustrated in Figures 2A-2C, 3 and 4 can potentially be performed together without conducting an additional search. Thus, the restriction requirement should be withdrawn or modified accordingly.

Based on the foregoing, the Applicants assert that the election requirement with respect to the Species is improper, and should be withdrawn. Consequently, the claims of Species I-III, comprising claims 69-120, should be examined together as required by the Species designations of the Patent Office, and pursuant to MPEP 802.01 and 803.